



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/525,259	09/08/95	DORN	C 18747ID

J ERIC THIES
MERCK AND COMPANY INC
PATENT DEPT PO BOX 2000
RAHWAY NJ 07065-0907

12M1/1001

EXAMINER	
GRUMBLIN, R	
ART UNIT	PAPER NUMBER
1202	4

DATE MAILED:

10/01/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents



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OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☒ This action is FINAL.
- ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.138(a).

Disposition of Claims

- ☒ Claim(s) 1-28 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-28 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or selection requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s): _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

Art Unit: 1202

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over, or in the alternative are rejected under 35 U.S.C. 102(e) as being anticipated by Dorn et al., US 5,512,570.

Art Unit: 1202

The reference teaches substance P-inhibiting morpholines, especially compounds 1-601, processes of making the same, and a process of using the same for treating emesis. Thus the reference anticipates the compounds of the instant invention, the processes of making the same and the processes of using the same. In the alternative, it is noted that the reference generically teaches a class of morpholines and thiomorpholines which differ from the instant claims in scope only. One of ordinary skill in the art, being apprised of the Dorn et al. patent would have been motivated to prepare any of the compounds therein by any of the processes therein and to have used them as taught therein, including compounds, processes of making and processes of using embraced by instant claims, because the compounds are taught by the reference to possess a body of advantageous properties.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over, or in the alternative are rejected under 35 U.S.C. 102(a) as being anticipated by Dorn et al., EP 577,394 or Barker et al., WO 95/18124. The references teach substance P-inhibiting morpholines, especially compounds 1-601, processes of making the same, and a process of using the same for treating emesis. Thus the references anticipate the compounds of the instant invention, the processes of making the same and the processes of using the same. In the alternative, it is noted that the reference generically teaches a class of morpholines and thiomorpholines which differ from the instant claims in scope only. One of ordinary skill in the art, being apprised of either the Dorn et al. or the Baker et al. publication would have been motivated to prepare any of the compounds therein by any of the processes therein and to have used them as taught therein, including

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compounds, processes of making and processes of using embraced by instant claims, because the compounds are taught by the reference to possess a body of advantageous properties.

Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "are as defined above" is objected to wherever it appears is in the claims as it is not clear where "above" the substituents are defined. It is suggested that where the substituent variables are already defined elsewhere in the claim, the phrase should be struck altogether. The phrase should also be struck where the substituent variable is defined in the base claim for the claim in which the phrase occurs. If "above" refers to the specification, this is objected to. Correction is required.

Applicants are requested to furnish any references cited in the specification but not previously provided in order to complete the record and because they are not readily available to the examiner.

Claims 1-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 5,512,570. The patent claims are drawn to methods of treating emesis by using substance P-inhibiting morpholines and thiomorpholines which differ from the instant claims in scope only. One of ordinary skill in the art, being apprised of the Dorn et al. patent would have been motivated to prepare any of the compounds therein by any of the processes therein and to have used them as taught therein,

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including compounds, processes of making and processes of using embraced by instant claims, because the compounds are taught by the reference to possess a body of advantageous properties.

The prior art cited but not applied is relevant as background only.

The Kaufman and Laduwahetty et al. references are drawn to compounds which are structurally similar to the compounds of the instant invention, which differ as homologs of the instant claims since they correspond to theoretical compounds corresponding to the claims such that Z is Hydrogen which would be homologous to compounds in which Z is methyl. However, the references cited in rejections above are considered closer to the claims than the Kaufman and Laduwahetty et al. references as they actually overlap in scope and evidence overcoming the closer references would likely overcome any rejection made over Kaufman or Laduwahetty et al. For this reason the Kaufman and Laduwahetty et al. references are deemed cumulative with the prior art cited against the claims above.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew V. Grumbling whose telephone number is (703) 308-4713. The examiner can usually be reached on Monday through Friday from 9:30 a.m until 6:00 p.m.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

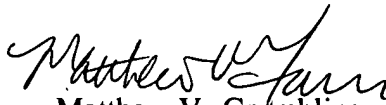
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A facsimile center has been established in Group 1200, room 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine are (703) 308-4556 or 305-3592.

Since the facsimile machines possess limited capacity it is requested that information disclosures, appeal briefs and other communications greater than 15 pages in length be mailed rather than submitted by facsimile. Also it is requested that communication not intended to be entered in the case (such as courtesy copies) be conspicuously marked "DRAFT" on the cover sheet of the facsimile transmission.



Matthew V. Grumbling

Patent Examiner

GAU 1202

September 30, 1996